REMARKS

In accordance with the foregoing, claims 1-4 and 6-10 have been amended. Claim 5 has been cancelled. Claims 11-13 have been added. Claims 1-4 and 6-13 are pending and under consideration.

Rejections under 35 U.S.C. § 101

In item 1 on page 2 of the March 3, 2005 Office Action (hereafter "Office Action") claims 1-8 were rejected under 35 U.S.C. § 101 as non-statutory, specifically, not directed to the technological arts. Independent claim 1 has been amended to recite in the preamble a "computer implemented method of directing a computer" (claim 1, lines 1-2) and in the body "processing in a computer system buying and selling orders" (claim 1, line 6). Therefore, independent claim 1 and dependent claims 2-4 and 6-8 are directed to statutory subject matter within the technological arts. The rejection of dependent claim 5 is moot because claim 5 is canceled. It is respectfully requested that the 35 U.S.C. § 101 rejections of claims 1-4 and 6-8 be withdrawn.

Rejections under 35 U.S.C. § 112

In item 2 of page 2 of the Office Action claims 1-10 were rejected under 35 U.S.C. § 112, second paragraph, because "acquiring a trade price" was alleged to be indefinite; "the trade price meets the suggested offering price" was alleged to be unclear; and an "allowable range around the suggested offering price" and an "excessive difference" were alleged to be undefined. These rejections are respectfully traversed.

Independent claims 1, 9 and 10 and dependent claim 2 have been amended to recite limitations associated with "identifying a trade price" (e.g., claim 1, line 7) executed "in a secondary market" (e.g., claim 1, lines 5-6) instead of acquiring a trade price. In addition, in dependent claims 1, 9 and 10 have been amended to replace the term "meets" with the phrase "is below"; independent claims 1, 9 and 10 and dependent claim 6 have been amended to better define the scope of the invention concerning an "allowable range around the suggested offering price" as defined in the specification at least at page 14, lines 17-27; page 15, lines 1-17; and Figure 7); and independent claims 1, 9 and 10 have been amended to better define the scope of the invention concerning an "excessive difference" between the trade price and the suggested offering price. Thus, it is respectfully requested that the 35 U.S.C. § 112, second paragraph rejections be withdrawn.

Rejections under 35 U.S.C. § 103

In items 4-5 of the Office Action, claims 1-12 were rejected under 35 U.S.C. § 103(a) as unpatentable over "Wit Capital (selected documents)" (hereafter "Wit") in view of "Gerard et al., Trading and Manipulation Around Seasoned Equity Offerings, The Journal of Finance 1993" (hereafter "Gerard"). The rejections are respectfully traversed.

The Office Action failed to establish a case of *prima facie* obviousness over Wit in view of Gerard for claims 1-12 for the following reasons: (1) the Office Action attempted to rely on Official Notice evidence to allege obviousness of the invention itself; (2) the Office Action reached an unsubstantiated, ambiguous conclusion of obviousness; (3) the Office Action presented an omnibus rejection; (4) the Office Action relied on Official Notice combined with an omnibus rejection to reject claims 3-8; (5) the Office Action relied on impermissible hindsight to reach a conclusion of obviousness; and (6) the listed secondary reference was not cited in the rejection of the claims.

With respect to reason (1); the Office Action at page 3, lines 14-19 admitted the prior art fails to teach the last element in each of independent claims 1, 9 and 10. The Examiner's attention is directed to MPEP 2144.03 which states that "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based" citing *In re Zurko*, 258, F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed.Cir. 2001).

With respect to reason (2), the Office Action reached an unsubstantiated, ambiguous conclusion of obviousness by equating the pursuit "of trading arbitrage opportunities" with a showing of the missing claimed elements of the invention.

With respect to reason (3), the Office Action presented an omnibus rejection directed to independent claims 1, 9 and 10, not incompliance with 37 CFR § 1.104(c)(2) improperly expressing the rejection by failing to show the particular part of the references relied on designated as nearly as practicable.

With respect to reason (4), the Office Action relied on Official Notice combined with an omnibus rejection in improperly expressing the rejection of claims 3-8.

With respect to reasons (5) and (6), the Office Action relied on impermissible hindsight to reach a conclusion of obviousness and the body of the rejection lacks any mention of the secondary reference presented in the preamble of grounds for a rejection under 35 U.S.C. §

103, even though the Office Action on page 4 asserted that it would have been obvious for one skilled in the art to combine the references.

Thus, based on the reasons presented above showing the errors in the Office Action's obviousness rejections of claims 1-12, Applicant respectfully request that either an Examiner's affidavit or references suggesting or explicitly showing the Officially Noted, allegedly well known elements and limitations be presented in the next Office Action.

A case of *prima facie* obviousness has not been established for claims 1-4 and 6-12. Therefore, it is respectfully requested that the obviousness rejections of claims 1-4 and 6-12 be withdrawn. Furthermore, the claims distinguish over the applied art because nothing has been cited in the applied art references that teaches or suggests "identifying a trade price at which the buying and selling orders have been executed in the secondary market" (claim 1, lines 7-8) and nothing has been cited in the applied art references that teaches or suggests "repetitively placing an additional buying order for a predetermined quantity at the suggested offering price at predetermined intervals" (claim 1, lines 17-18).

New Claims

Newly added independent claim 11 recites "placing one of a buying and selling order at a selected trade price ... as designated in a secondary market" (claim 11, lines 4-6). Thus, for reasons similar to those discussed above with respect to claim 1, claim 11 also distinguishes over the applied art. Therefore, claim 11 and dependent claims 12 and 13 are allowable.

Conclusion

It is submitted that the references cited by the Examiner, taken individually or in combination, do not reach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-4 and 6-13 are in a condition suitable for allowance. Entry of the Amendment, reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
on JULY 11, 20 05
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